

### **Remarks**

The Office Action mailed November 14, 2007 has been carefully reviewed and the foregoing amendment has been made in consequence thereof.

Claims 1-11, 20-32, and 48 are pending in this application. Claims 1-11, 20-32, and 48 stand rejected. No new matter has been added.

#### I. The § 112 Rejections

The pending claims stand rejected under the provisions of 35 U.S.C. § 112, ¶¶ 1 and 2.

##### A. The Written Description Rejection

The rejection of claims 1-11, 20-32, and 48 under 35 U.S.C. § 112, ¶ 1 for failing to comply with the written description requirement is respectfully traversed.

The Office Action states that the phrase “contractual provision” was not in the original disclosure, and the original disclosure does not use the word “provision” in relation to the deal. Applicants respectfully submit that these observations, on their own, do not raise a written description issue.

As explained in the MPEP, when a disclosure describes a claimed invention in a manner that permits one skilled in the art to reasonably conclude that the inventor possessed the claimed invention the written description requirement is satisfied. (MPEP §2163 (emphasis added)). This possession may be shown in any number of ways and an Applicant need not describe every claim feature exactly because there is no word-for-word requirement. (MPEP § 2163). Rather, to satisfy the written description requirement, all that is required is “reasonable clarity.” (MPEP § 2163.02). Also, an adequate description may be made in any way through express, implicit, or even inherent disclosures in the application, including words, structures, figures, diagrams, and/or formulae. (MPEP §§ 2163(I), 2163.02). Finally, it is important to be mindful of the

generally inverse correlation between the level of skill and knowledge in the art and the specificity of disclosure necessary to satisfy the written description requirement. (MPEP § 2163(II)(A)(2)) (inventions in “predictable” or “mature” arts require a lesser showing of possession than inventions in more “unpredictable” arts).

Turning to the present rejection, it is believed to be reasonably clear from the disclosure and accompanying figures at the time of filing that the documents relate to contractual agreements and provisions. While not required to satisfy the written description requirement, the word “contract” does appear at least in Figure 14. Figure 9 lists a variety of document structures that are recognizable to legal contracts, including but not limited to various types of Security Agreements and an Unsecured Creditor Agreement. Figure 16 clearly refers to LEGAL ENTITIES. Figure 17A refers to trust mortgage documents. Paragraph [0032] of the specification as filed states that the system “allows an attorney to review the document before it is presented to the parties.” The Office Action quotes to portions of the specifications referring to commercial financing, acquisitions, and real estate documents that are characterized by legal documents and contracts.

In light of the above, it is respectfully submitted that a person skilled in the art would recognize in the Applicants’ disclosure a description of the invention defined by the claims, including the contractual provisions as recited, and the written description requirement is therefore satisfied. (*See* MPEP § 2163(III)(A)).

Applicants accordingly request that the rejection of claims 1-11, 20-32, and 48 under 35 U.S.C. § 112, ¶ 1 be reconsidered and withdrawn.

#### B. The Indefiniteness Rejection

The rejection of claims 1-11, 20-32, and 48 under 35 U.S.C. § 112, ¶ 2 as indefinite is respectfully traversed.

The rejection states that the claims are indefinite because the phrase “contractual provision” does not appear in the original disclosure. This is an improper basis for rejecting a claim indefinite under § 112 ¶ 2.

Applicants refer to the Office Examination Policy regarding rejections under Section 112 that, consistent with the applicable law, notes that the essential question under § 112 ¶ 2 is whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. If the scope of the invention sought to be patented cannot be determined from the language of the claims, a § 112 ¶ 2 rejection is appropriate. Such rejections are inappropriate, however, when the disclosure and claims are sufficient for one skilled in the art to understand. The present claims are submitted to be clear, precise and particular in their scope, which is all that § 112 ¶ 2 requires.

Notably, the rejection does not state that the claims are ambiguous, unclear, or not amenable to reasonable interpretation, nor do Applicants believe that the meaning of the phrase “contractual provision” could be seriously debated in the context of the presently claimed subject matter. Alternatively stated, those in the art to which the invention pertains would immediately appreciate and understand this phrase. On this note, the phrase “complex transaction” suggested in the Office Action appears to present a much clearer § 112 ¶ 2 regarding whether either the words “complex” or “transaction” are susceptible to particular meaning in a predictable fashion.

Applicants accordingly request that the rejection of claims 1-11, 20-32, and 48 under 35 U.S.C. § 112, ¶ 2 be reconsidered and be withdrawn.

## II. Interpretation of Claim Language

Applicants do not agree that “contractual provision” should be read as a “complex transaction” as the Office Action suggests on page 5 thereof. Applicants express concern that this interpretation as explained in the Office Action improperly imports portions of the specification into the claims, is generally unnecessary, and is potentially misleading.

While Applicants would agree that contractual provisions and complex transactions often occur simultaneously, this is not necessarily so. In particular, the word “transaction” is believed to extend in scope well beyond the realm of legal contracts and would literally encompass activities not contemplated by the Applicants and not intended to be within the scope of their claims. As one example, the filing of a tax return for a sophisticated entity, and submission of the proper payment of taxes, may fairly be considered a complex business transaction, without implicating contractual provisions and the documents that the present invention concerns. The Broadbent disclosure, discussed below, that relates to loan application and compliance issues, is another example of an alleged complex transaction that would not utilize the contractual provisions and documents that the present invention concerns.

Applicants submit that a “contractual provision” should be given its ordinary and customary meaning that is well understood by those in the art, and which Applicants invoked when using the phrase in the first instance. Any other meaning is respectfully submitted to be inappropriate, inconsistent with the specification and ordinary meaning of the words used, and unreasonable.

### III. The Section 103 Rejections

The rejection of claims 1-11, 20-31 and 48 as being unpatentable over Foy et al. (US Patent Application Publication No. 2002/0046235) in view of Broadbent (U.S. Patent Application Publication No. 2001/0047326) is respectfully traversed.

As a preliminary matter, it is noted that the rejection refers to the Broadbent reference with a different publication number that corresponds to the Pope reference that was previously cited and apparently not relied upon in the present rejection. Applicants assume that this was an inadvertent mistake in the rejection and will respond with the understanding that the Broadbent reference (U.S. Patent Application Publication No. 2001/0047326) was intended to be referenced in the rejection.

Applicants respectfully submit that neither Foy nor Broadbent, considered alone or in combination, describe or suggest the claimed assembly production system.

The Foy reference has been studied in detail, and is not believed to be as close to the subject matter claimed as the Office Action would suggest. For example, independent claim 1 recites, among other things, a server configured to “display *document structure questions* on the remote computer” and display *transaction questions* on the remote computer.” In the Office Action paragraph 39 of Foy is cited against each of the document structure questions, the transaction questions, and related recitations of independent claim 1.

Paragraph 39 of Foy discloses questions 110 for identifying content to be included in a document template, and questions 116 for “user specific data” required for inclusion in the document. Foy, however, never actually state what the “user specific data” is, nor does Foy define who the user is, so it is not clear at all that the user specific data correspond to the transaction questions recited in claim 1. Paragraph 33 of Foy refers to “user specific data . . . for populating any clauses of the documents requiring such data,” suggesting the that user specific data is optional for the Foy system in at least certain applications. Paragraph 45 of Foy states that a completed document, including “personal data” can be made available to the user. The “personal data” is not defined either, but it is not unreasonable to assume that this may be the “user specific data” described elsewhere by Foy. Applicants will refrain from speculating what the personal, user specific data alluded to by Foy might be, but will submit that the transaction questions recited in claim 1 are not consistent with what little Foy has to say about the personal, user specific data. The transaction questions recited are neither optional nor personal to the user as Foy describes in relation to the user specific data disclosed. The Broadbent reference does not cure the deficiencies of Foy in this regard.

The Office Action concedes that Foy does not disclose, as recited in independent claim 1, that “each document type represents specific contractual provisions typically associated with completing the corresponding transaction type” and “the document structure questions

identifying a predetermined plurality of contractual provisions that the user can select from for inclusion within the assembled document.” It is further conceded in the Office Action that Broadbent does not disclose “the document structure questions linked to specific document types representing the predetermined plurality of contractual provisions, wherein by responding to the document structure questions the user includes the selected contractual provisions within the assembled document to complete the transaction type.” The Office Action cites the Broadbent reference as teaching these features. Applicants disagree.

Broadbent describes a system for preparing a task list for a loan process. The Broadbent system is used in the mortgage industry for generating and monitoring a set of required procedures involved in moving and tracking a mortgage loan, including generating a set of required tasks for use in managing the mortgage loan process. Broadbent describes input screens for prompting a borrower to input data relating to a mortgage loan. These input screens may include a list of questions. Input screens to be completed by the borrower are shown in Figures 7-18 of the Broadbent reference, and it is apparent therefrom that the borrower is not being asked to select contractual provisions. Indeed, the mortgage application is not a contract at all. Nothing in the Broadbent disclosures states or suggests that any user may select certain contract provisions to the exclusion of others.

Contrary to the assertion otherwise in the Office Action, Foy in view of Broadbent does not describe or suggest, in combination with the other recitations of claim 1, a document assembly production system wherein each document type represents specific contractual provisions typically associated with completing the corresponding transaction type, the document structure questions identifying a predetermined plurality of contractual provisions that the user can select from for inclusion within the assembled document, and the document structure questions being linked to specific document types representing the predetermined plurality of contractual provisions, wherein by responding to the document structure questions the user includes the selected contractual provisions within the assembled document to complete

the transaction type. The combination of Foy and Broadbent simply fail to teach or suggest all the recitations of claim 1.

Claim 1 is therefore submitted to be patentable over Foy in view of Broadbent. When the recitations of dependent claims 2-11 and 48 are considered in combination with the recitations of claim 1, claims 2-11 and 48 are likewise submitted to be patentable over Foy in view of Broadbent.

Some of the dependent claims stand rejected for reasons that do not have a clear relation to the actual language of the claims and Applicants request clarification of the rejections therefor. For example, the portions of the Foy reference cited against claim 4 do not appear to implicate the restructuring and reassembly of documents recited in claim 4. The rejection of claim 5 presents a similar issue. Structuring versus restructuring, or assembling versus reassembling, are not believed to be the same, although the Office appears to treating them as if they were. Furthermore, restructuring or reassembling as claimed is not believed to be obvious.

The language of claim 7 also is not clearly reflected in the explanation of Foy set forth in the Office Action. It is respectfully submitted that the language of claim 7 does not refer to the creation of two documents simultaneously as the Office Action appears to suggest, nor would the creation of two documents simultaneously render claim 7 obvious.

The workflow status of a document assembly as recited in claim 8 is not believed to be suggested by the Loan Fulfillment Workflow Engine of Broadbent as cited against claim 8. The Broadbent Workflow Engine is for the benefit of managing tasks to be performed by multiple “workers” or “agents” that may include multiple and different individuals, organizations, data tables, data processing systems, etc. This is not the workflow status for a document assembly as recited in claim 8. The report of claims 9 and 10 presents a similar issue, and is not believed to be obvious over the Loan Fulfillment Workflow Engine of Broadbent. Any interpretation of the

claimed “assembly of the fully-formatted documents” that would encompass the Loan Fulfillment Workflow Engine of Broadbent is respectfully submitted to be unreasonable.

Independent claim 20 recites similar features to independent claim 1 and is patentable over Foy in view of Broadbent for similar reasons. When the recitations of dependent claims 21-32 are considered in combination with the recitations of claim 20, claims 20-32 are likewise submitted to be patentable over Foy in view of Broadbent. Subject matter in some of these dependent claims also does not appear to be suggested by the cited art, including but not limited to parallel language of some of the dependent claims discussed above.

For at least the reasons set forth above, Applicants respectfully request that the rejection of Claims 1-11, 20-32, and 48 under 35 U.S.C. § 103(a) be withdrawn.

In view of the foregoing amendments and remarks, all the Claims now active in the application are believed to be in condition for allowance. Favorable action is respectfully solicited.

Respectfully Submitted,



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